

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARK KRULL and GREGORY WELTE

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Appeal No. 2002-0267  
Application No. 09/440,496

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ON BRIEF

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Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 64-89,<sup>1</sup> which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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<sup>1</sup>Claim 89 apparently inadvertently was not listed in the statement of the rejection Answer.

### BACKGROUND

The appellants' invention relates to a coin display. An understanding of the invention can be derived from a reading of exemplary claim 64, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|           |           |               |
|-----------|-----------|---------------|
| Ball      | 2,860,774 | Nov. 18, 1958 |
| Di Egidio | 4,552,357 | Nov. 12, 1985 |

"States Of The Union Penny Treasury," circa 1976<sup>2</sup> (Penny Map)

Claims 64-89 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Penny Map in view of Di Egidio and Ball.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 19) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 18) and Reply Brief (Paper No. 20) for the appellants' arguments thereagainst.

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<sup>2</sup>This reference was submitted by the appellants by way of a supplementary information disclosure statement (Paper No. 8). According to the appellants, it was provided by patent counsel to a third party, who provided a synopsis of its contents and stated that it was first sold in the United States in 1976. The appellants have stated in Paper No. 8 that they were willing "to accept it as accurate."

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we wish to focus upon the appellants' argument that Di Egidio and Ball are non-analogous art and therefore cannot properly be used in the rejection (Brief, pages 6 and 7). The test for analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. See In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. See In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

Di Egidio is directed to a sports geography game in which tokens are placed in openings in a map of the continental United States, based upon the location of cities within the various states. Interestingly, the appellants also have characterized their invention as a "game" (specification, page 5), and have stated on the preceding page that it can be used to display "quarter-sized" objects, such as tokens, which are distinguishable on a state by state basis. This would seem on its face to place

Di Egidio within the field of the appellants' endeavor, as well as commending itself to the appellants' attention in view of the fact that it utilizes an outline of the states of the continental United States as its playing board, and receives tokens in openings in the board. Ball is directed to boards for mounting collections of coins for display, which coincides with the title of the appellants' invention. Moreover, the appellants have not provided reasons why the two references do not fall within the categories set forth above in Wood and Clay, but have compared their relevance to one another, which is not the required legal test. It is our opinion that both Di Egidio and Ball are analogous art.

All of the claims before us stand rejected under 35 U.S.C. § 103(a). The question under Section 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co. v. Biotech Labs., Inc. 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozak, 416 F.2d 1385, 1390, 163 USPQ 545, 549

(CCPA 1969). Insofar as the references themselves are concerned, we are bound to consider the disclosure of each for what it fairly teaches one of ordinary skill in the art, including not only the specific teachings, but also the inferences which one of ordinary skill in the art would reasonably have been expected to draw therefrom. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966) and In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Claim 64 reads as follows:

A coin display, comprising:

a board having at least a first section and a second section which are foldable relative to one another along a fold line, wherein the board bears an outline of the continental United States, and an outline of each individual state within the continental United States;

for each state within the continental United States, a separate opening in the board, including a first opening disposed within the first section and at least partially inside the outline of a first state within the continental United States, and a second opening disposed within the section and at least partially inside the outline of a second state of the continental United States, wherein each opening is disposed away from the fold line, and each opening has a diameter of approximately 15/16 of an inch; and

a coin bearing the name of a particular state within the continental United States, wherein the coin is secured with the opening for the particular state.

Looking first to independent claim 64, Penny Map discloses a board<sup>3</sup> bearing an outline of the continental United States, an outline of each individual state within the continental United States, and a separate opening for each state within the continental United States, including openings at least partially inside the outline of many of the states in the eastern, western, northern and southern portions of the map, and a coin bearing the name of a particular state within the continental United States secured within the openings for the particular state. Penny Map fails to explicitly teach (1) that the map has at least a first section and a second section which are foldable relative to one another along a fold line, (2) that the openings are disposed away from the fold line, and (3) that the openings have a diameter of approximately 15/16 of an inch.

With regard to item (1), we first point that the appellants describe their invention on page 1 of the specification as “also being provided in the form of a game,” and we would venture to advance without formal evidence the position that it was well known in the art of games at the time of the appellants’ invention to provide game boards having at least two sections which were foldable relative to one another, if for no other reason than to facilitate storage when not in use. This position confirmed by Di Egidio, which discloses a sports geography game comprising an outline of the continental United States and each individual state within the continental United States, and which has

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<sup>3</sup>We note in this regard that the synopsis provided by counsel for a third party with the submission of this reference states that it “comprises a board bearing the image of all fifty states” (emphasis added). The appellants have not disputed this statement.

first and second equally sized portions (12 and 14) that are foldable with respect to one another. It also is confirmed by Ball, which discloses a coin display device comprising a number of sections which are foldable relative to one another between a storage position and a display position (column 1, lines 15-22). We agree with the examiner that one of ordinary skill in the art would have found it obvious to fold the Penny Map into two sections relative to one another along a fold line to facilitate storage in view of the teachings of Di Egidio, Ball, and skill in the art, considering that in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

With regard to (2) above, from our perspective, one of ordinary skill in the art would recognize the clear error of placing openings within which coins or the like are to be stored or positioned along the fold line of a board, for to do so would preclude folding until the items are removed from the openings in which they are held. In re Sovish, supra. This is documented by Ball. We agree with the examiner that it would have been obvious to position the openings away from the fold lines in the modified Penny Map.

The appellants have admitted on page 3 of their specification that those skilled in the art would recognize that different sizes of openings could be used in the board. It thus would appear that the size specified in claim 64 is not critical, but need merely accommodate the coin or token being utilized on the map, which in this case is a United

States quarter. It therefore is our view that it would have been obvious to one of ordinary skill in the art to provide Penny Map with 15/16 inch openings rather than the penny openings which are disclosed.

It therefore is our conclusion that the combined teachings of the applied references establish a prima facie case of obviousness with regard to the subject matter recited in claim 64, and we shall sustain the rejection. Since the appellants have grouped claims 65-71 with claim 64, from which they depend, the rejection of these claims also is sustained.

Claims 72, which depends from claim 64 through claim 71, and claim 74, which depends directly from claim 64, each contain the limitation that the first section and the second section of the board are identical in size and shape. Both Di Egidio and Ball are evidence that it was well known in the art at the time of the appellants' invention to fold such boards so that all of the folded sections are of the same size and shape. Additionally, it is our view that to cause a board to be folded at its mid-point, which is what this claim requires, would have been an obvious expedient well within the skill which must be accorded one of ordinary skill in the art. We therefore conclude that it would have been obvious to provide the Penny Map board with this feature, and we will sustain the rejection of these two claims.

We reach the opposite conclusion, however, with regard to claims 73 and 75, which require that the outline of Minnesota be disposed entirely on the first section.



Noting, that none of the references teach placing Minnesota, or any other state through which a center fold line would pass, entirely on one side or the other of the fold line, the rejection of claims 73 and 75 cannot be sustained on the basis of the evidence adduced by the examiner.

The subject matter recited in independent claim 76 is much like that of claim 64, differing in that it requires that the board be bounded by a bottom edge which extends along each section and is perpendicular to the fold line, so that both the coins and the outline of the continental United States may be viewed by angling the first section relative to the second section when resting the bottom edge on a flat surface. Penny Map is rectangular, and comprises a “board” that, when modified in the manner discussed with regard to claim 64, and in the absence of evidence to the contrary, would appear to be capable of being positioned in the manner required by the claim. The Ball display system also is capable of standing on one edge, as is illustrated in Figure 1. Therefore, it is our conclusion that the combined teachings of the applied references establish a prima facie case of obviousness with regard to the subject matter recited in claim 76, and we will sustain this rejection, along with that of dependent claim 77.

The rejection of claims 78 and 80, which require identity of size and shape, is sustained for the same reason as was the like rejection of claims 72 and 74.

The rejection of claims 79 and 81, which place the entirety of Minnesota in one of the sections, is not sustained.

Independent claim 82 sets forth the same basic invention as claims 64 and 76. It contains the limitation of attaching the first and second portions of the board together with flexible material which defines a gap between the sections. This type of attachment means for display boards is disclosed by Ball, for the purpose of allowing the leaves folded into accordion pleats for storage and then to be completely unfolded to display all the coins at one time (column 1, lines 18-22). It is our view that it would have been obvious to one of ordinary skill in the art to separate the board sections in the modified Penny Map and to attach them together in the manner required by claim 82 in view of the explicit advantages of such set forth by Ball. The applied references thus establish a prima facie case of obviousness with regard to the subject matter recited in claim 82, and we will sustain the rejection of this claim and of claims 83, 88 and 89, which were grouped therewith.

The rejection of claims 82 and 84, which add the equal size and shape limitation, is sustained for the reasons set forth above with regard to claims 72 and 74.

The rejection of claims 85 and 87, which add the limitation directed to Minnesota, is not sustained.

In arriving at the foregoing decisions, we have carefully considered all of the sixty-three pages of argument presented in the Brief and the Reply Brief. Except for the

limitation regarding Minnesota, we do not agree with the positions and theories set forth by the appellants. The analogous art argument has been dealt with above. In addition, we point out that in a rejection under Section 103, it is not necessary that each and every limitation in a claim be taught by a single reference. As should be apparent from the guidance provided by our reviewing court with regard to rejections under 35 U.S.C. § 103, the issue is what the prior art would have taught or suggested to one of ordinary skill in the art, whose skill in the art cannot be ignored. It is our view that the requisite teachings and suggestion to combine the references in the manner proposed by the examiner are present in every case except for the claims containing the Minnesota limitation. Regarding the argument that Penny Map does not comprise a “board,” we point out that this was set forth in the synopsis provided by counsel for a third party, which the appellants accepted in Paper No. 8 as “being accurate.” With regard to the allegation that the rejections we sustained are based upon hindsight, we wish to note that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). We believe that to be the case here.

#### CONCLUSION

The rejection of claims 64-72, 74, 76, 77, 80, 82, 83, 84, 86, 88 and 89 is sustained.

The rejection of claims 73, 75, 79, 81, 85 and 87 is not sustained.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

NEAL E. ABRAMS )  
Administrative Patent Judge )

CHARLES E. FRANKFORT  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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